UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,726	09/22/2003	Chaitanya Dev Sareen	60001.0284US01/305087.1	9701

7590   09/25/2007

Leonard J. Hope
Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER
ANWARI, MACEEH

ART UNIT	PAPER NUMBER
2144	

MAIL DATE	DELIVERY MODE
09/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/667,726	SAREEN ET AL.
	Examiner	**Art Unit**
	Maceeh Anwari	2144

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 September 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/30/2004</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

This is the initial Office action based on the 10/667726 application filed on
9/22/2003. Claims 1-20, as originally filled, are currently pending and have been
considered below.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 6 & 15 are rejected under 35 U.S.C. 101 because The claims fail to place the
invention squarely within one statutory class of invention. On page 5, lines 13-16 of the
instant specification, applicant has provided evidence that applicant intends the
"medium" to include signals. As such, the claim is drawn to a form of energy. Energy is
not one of the four categories of invention and therefore this claim(s) is/are not
statutory. Energy is not a series of steps or acts and thus is not a process. Energy is
not a physical article or object and as such is not a machine or manufacture. Energy is
not a combination of substances and therefore not a composition of matter.

Claim 7 & 16 is rejected under 35 U.S.C. 101 because the claim lacks the
necessary physical articles or objects to constitute a machine or a manufacture within
the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a
process nor are they a combination of chemical compounds to be a composition of
matter. As such, they fail to fall within a statutory category. They are, at best, functional
descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "non-functional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When <u>functional</u> descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross et al. (hereinafter Gross) U.S. Patent NO.: 5,283,856.

Gross teaches:

Claim1: A method for identifying to a user the cause of an event occurring within a computer system, the method comprising: maintaining at the computer system a rule comprising one or more conditions and one or more actions that are performed when the one or more conditions are satisfied (Figures 1-11A and Abstract; event driven, conditional rule based messaging system and a rule mechanism); periodically performing an evaluation to determine whether the conditions are satisfied (Figures 1-11A and Abstract & Col. 5 lines 43-55; periodic or timed occurrences); performing the one or more actions in response to determining that the conditions are satisfied (Figures 1-11A and Abstract & Col. 5 lines 43-65; periodic or timed occurrences and timer and timer event); receiving a request to identify the cause of the performance of the one or more actions (Figures 1-11A and Abstract & Col. 5 lines 43-65; event manager, timer and timer event); and in response to receiving the request, identifying the rule to the user (Figures 1-11A and Abstract & Col. 5 lines 43-65; event manager, event mechanism and applying rule to selected object).

Claim2: Wherein the one or more conditions comprise receiving an electronic mail message and wherein the one or more actions comprise displaying a first user interface dialog box indicating that the electronic mail message has been received (Figures 1-11A and Abstract & Col. 5 lines 43-65; event manager, event mechanism, event user function and message transport access layer and GUI).

Claim3: Wherein the first user interface dialog box comprises a user interface

object that, when selected, displays a second user interface dialog box that identifies the rule (Figures 1-11A and Abstract & Col. 5 lines 43-65; pointer or tag points to a rule in a rule data base).

Claim4: Wherein receiving a request to identify the cause of the performance of the one or more actions comprises receiving a selection of the user interface object (Figures 1-11A and Abstract; user interface, rule mechanism interface and host operating system).

Claim 5: Wherein identifying the rule to the user comprises displaying a user interface object that identifies the rule (Figures 1-11A and Abstract & Col. 5 lines 43-65; event manager, event mechanism, event user function and message transport access layer and GUI).

Claims 6 -7 are substantially the same as **claim 1** and are thus rejected for reasons similar to those in rejecting **claim 1.**

Claims 8 –11 are substantially the same as **claims 1-5** and are thus rejected for reasons similar to those in rejecting **claim 1-5.**

Claim 12: Wherein the first indication further comprises a user interface object that, when selected, will open the selected message for viewing (Figures 1-11A and Abstract; user interface, GUI, and event manager and on-disk persistent event manager).

Claim 13: Wherein the first indication further comprises a user interface object which, when selected, will dismiss the first indication (Figures 1-11A and Abstract; user interface, GUI, and event manager and on-disk persistent event

manager).

Claim 14: Wherein the second indication further comprises one or more user interface objects which, when selected, provide functionality for editing the rule.

Claims 15 -16 are substantially the same as **claim 8** and are thus rejected for reasons similar to those in rejecting **claim 8.**

Claim 17: A method for identifying to a computer user the cause of an event occurring within a computer system, the method comprising: storing within the computer system one or more user-defined message handling rules, at least one of the rules operative to generate a first indication message in response to receiving at the computer system an electronic mail message satisfying one or more conditions (Figures 1-11A and Abstract; event driven, conditional rule based messaging system and a rule mechanism and storage folders); receiving an electronic mail message (Figures 1-11A and Abstract; event driven, conditional rule based messaging system and a rule mechanism); in response to receiving the electronic mail message, performing an evaluation to determine if the one or more conditions are satisfied by the received message (Figures 1-11A and Abstract; event driven, conditional rule based messaging system and a rule mechanism and event manager); generating the first indication message in response to determining that the one or more conditions are satisfied by the received message (Figures 1-11A and Abstract; event driven, conditional rule based messaging system and a rule mechanism and an event manager with on disk persistent event manager); receiving a request to identify the rule that

caused the indication message to be displayed (Figures 1-11A and Abstract &

Col. 5 lines 43-65; pointer or tag points to a rule in a rule data base); and in

response to the request, generating a second indication message identifying the

rule that caused the first indication message to be displayed (Figures 1-11A and

Abstract; user interface, GUI, and event manager and on-disk persistent event

manager).

Claim 18: Wherein the first indication message comprises information related to

the received message (Figures 1-11A and Abstract; user interface, GUI, and

event manager and on-disk persistent event manager).

Claim 19: Wherein the request to identify the rule that caused the indication

message to be displayed comprises the selection of a user interface object

contained within the first indication (Figures 1-11A and Abstract; user interface,

rule mechanism interface and GUI).

Claim 20: Wherein the second indication message further comprises a facility for

editing the rule that caused the first indication message to be displayed (Figures

1-11A and Abstract; structured rule editor, rule editor and user interface).

**Examiner Note: Examiner has cited particular columns and line numbers in the
references as applied to the claims above for the convenience of the applicant.
Although the specified citations are representative of the teachings of the art and
are applied to the specific limitations within the individual claim, other passages
and figures may apply as well. It is respectfully requested from the applicant in
preparing responses, to fully consider the references in its entirety as potentially
teaching of all or part of the claimed invention, as well as the context of the
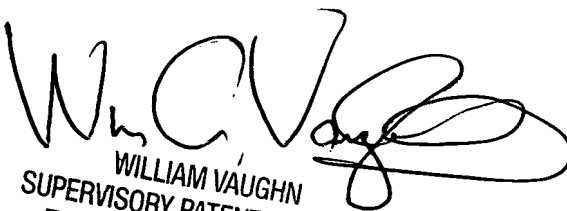passage as taught by the prior art or disclosed by the examiner.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maceeh Anwari whose telephone number is 571-272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.

WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100